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| 10/612,306      | 07/03/2003  | Hirobumi Toyoda      | 3022-0011           | 3185             |

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ALFRED A. STADNICKI  
ANTONELLI, TERRY, STOUT & KRAUS, LLP  
SUITE 1800  
ARLINGTON, VA 22209

EXAMINER

KARKHANIS, AASHISH

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3714

DATE MAILED: 08/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/612,306

Applicant(s)

TOYODA, HIROBUMI

Examiner

Aashish Karkhanis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received:

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4/05, 6/7/06, 12/1/03 AEU
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The following claim language is unclear, and should be rewritten without the insertion of new subject matter in order to more clearly and distinctly disclose the applicant's claimed invention; "first predetermined rank of the combination-making game under a predetermined condition so that the at least one combination is aligned along a first line among lines contained in the matrix, and a disbursement value determination means for determining amount of disbursement or a multiple number of a bet number of bets made by the player for disbursement depending on the first predetermined rank of the combination of the combination-making game if all cells with allocated symbols along the first line so as to make the first winning combination become effective after the predetermined number of lotteries are made with the matrix having symbols allocated to the respective cells thereof."

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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2. Claims 13 – 15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. Accordingly, it is important to distinguish claims that define descriptive material per se from claims that define statutory inventions.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 – 12 and 16 – 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Yoseloff et al. (U.S. Patent 6,311,976 B1).

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Regarding Claims 1 and 16, Yoseloff discloses a server connectable via a communication line to gaming machines (col. 14, lins. 28 – 29), with each of which a combination-making game is performed using a matrix which includes a row with a row cell number of at least two and a column with a column cell number of at least two, wherein the row cell number equals the column cell number so as to constitute the matrix containing a plurality of cells (col. 16, lins. 46 – 47; where a reel game may inherently have a number of configurations of cells and rows including a 5x5 matrix, as is well known and established in the art), each of which has an allocated symbol such that each corresponding cell becomes effective if the allocated symbol to the corresponding cell is selected by a main lottery (col. 16, lins. 48 – 50; where symbols are randomly selected and may be winning symbols in a first game), the gaming machine being characterized to provide a benefit to a player depending on a pattern of cells being effective after a predetermined number of main lotteries, the gaming machine including a symbol allocating means for allocating symbols to the respective cells such that at least one combination being composed of a same number of symbols as the row or column cell number matches a first predetermined winning combination with a first predetermined rank of the combination-making game under a predetermined condition so that the at least one combination is aligned along a first line among lines contained in the matrix (col. 1, lins. 47 – 49; where symbols combinations can occur on preset paylines), and a disbursement value determination means for determining amount of disbursement or a multiple number of a bet number of bets made by

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the player for disbursement depending on the first predetermined rank of the combination of the combination-making game if all cells with allocated symbols along the first line so as to make the first winning combination become effective after the predetermined number of lotteries are made with the matrix having symbols allocated to the respective cells thereof (col. 16, lins. 56 – 61; where a first game is a primary game and a special symbol combination triggers a bonus round after a randomly number of lotteries, where a result of the primary lottery is predetermined before a result is shown).

Regarding Claims 2 – 3, Yoseloff discloses a gaming machine wherein the combination-making game where the row cell number of the matrix is five (col. 16, lins. 46 – 47; where a reel game may inherently have a number of configurations of cells and rows including a 5x5 matrix, as is well known and established in the art), or the combination-making game comprises a mahjong game or a poker game (col. 1, lin. 17).

Regarding Claims 4 – 6, Yoseloff discloses a game machine including a betting means for betting game media in regard to the matrix, wherein the first winning combination that is aligned along the first line and is composed of symbols allocated by said symbol allocating means causes the gaming machine to provide a benefit to the player and the benefit, which is more than a predetermined standard, is based on a disbursable number of the game media or the multiple number of the bet number of the game media the player has bet (col. 16, lins. 56 – 61; where a first game is a primary game and a special symbol combination triggers a bonus round after a randomly number of lotteries, where a

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predetermined standard is a bonus triggering combination and disbursable media includes monetary credits that may be awarded to a player after a bonus round).

Regarding Claim 7, Yoseloff discloses a gaming machine wherein said symbol allocating means allocates symbols to the respective cells of the matrix such that the matrix contains a second line being constituted of a second combination with a second rank of the combination-making game, wherein said betting means allows the player to bet game media on the first and/or second lines, and wherein the gaming machine includes an effective line determination means for determining whether the first and/or second lines are applicable to disbursement of game media in accordance with a bet number of game media the player has bet if all cells of the first and second lines become effective (col. 1, lins. 47 – 49; where symbols combinations can occur on preset paylines, and awards can be given based on results that occur on paylines).

Regarding Claims 8 – 12, Yoseloff discloses a gaming machine including a preliminary cell validation means for making at least one cell contained in the matrix effective in accordance with a result of a preliminary lottery performed prior to said main lottery (col. 3, lins. 31 – 32; col. 4, lins. 23 – 24; where a wild symbol will become effective after other symbols have been setermined, usually causing a favorable result for a player).

Regarding Claim 17, Yoseloff discloses a gaming machine being connected to the server via said communication line including communicating means for communicating via said communication line with the server (col. 14,

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lins. 28 – 29) and displaying means for displaying progress of the game to the player (fig. 1).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent 6,299,170 B1: Reel game with wild cards.

U.S. Patent Application Publication 2002/0049082 A1: reel poker game with wild cards.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aashish Karkhanis whose telephone number is (571) 272-2774. The examiner can normally be reached on 0800-1630 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (571) 272-6788.

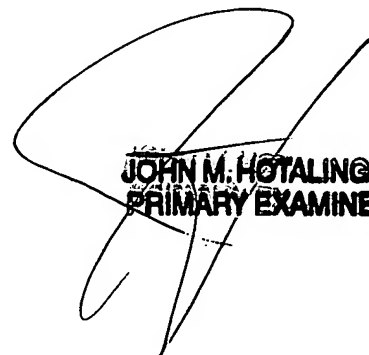
The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ARK



**JOHN M. HOTALING, II**  
**PRIMARY EXAMINER**